

REMARKS

The Office Action and have been reviewed and reconsideration of the above-identified application in view of the following amendments and remarks, is respectfully requested

Claims 1-18 are pending and stand rejected.

Claims 1, 4, 7, 10, 13 and 16 are independent claims.

No claims have been amended.

Claims 1-18 stand rejected under 35 USC 103(a) as being unpatentable over Salmonsén (USP no. 7, 209, 874) in view of Sato (USPPA 2003/0041123) further in view of Pak (USPPA 2004/0267790) and further in view of Silen (USPPA 2002/0116518).

In maintaining the rejection of the claims, the Office Action asserts that the “claimed amendments [c]learly change the literal scope of the independent and dependent claims and/or the range of equivalents for such claims. The said amendments alter the scope of the claims but do not overcome the disclosure by the prior art as shown below.”

In addition, in reply to the Applicant’s remarks, the Office Action states “[t]he applicant presents the following argument(s) ... *Pak explicitly teaches that the client environment is used in the selection process and any device that refers to Pak includes a quality menu that is dependent upon rendering capabilities. Otherwise, the device independent of the rendering capabilities is contrary to the teachings of Pak.[emphasis in original]*. The Applicant[’s] remarks appear to indicate that the client environment is specific to a device limitation, as in the device display resolution, physical display size. The Examiner respectfully disagrees with the Applicant. The Examiner notes that the limitation indicating ‘quality options being independent of rendering capabilities of said processing system’ is a negative limitation that does not further limit the claims. Upon inspection of Applicant[’s] Specifications Page 1, lines 20-30 the Examiner

interprets said 'quality options being independent of rendering capabilities of said processing system as a selection of available type of network connections and their corresponding bandwidth attributes (e.g., dial-up, ISDN, or broadband connection). Pak Figure 4 Paragraph 35, Paragraph 39 discloses wherein the client environment is referring to the network transmission velocity of a network data transmission channel available for downloading. The said network data channel transmission velocity is an attribute that is not tied to any particular device and is indicative of the type of network connection ... Pak Paragraph 51 disclosed selecting one quality of content based on the type of network connection. The Examiner notes that while Park discloses consideration of the 1) device rendering capabilities in addition to the 2) network data channel transmission velocity, it would be obvious ... to use one of the client environment attributes. ...[I]t would have been obvious to include the available network options by Pak such as network data channel transmission velocity with the pre-stored information disclosed by Sato, for the user rendering device to match the rendering options before making the download request for content. This would [be] an improvement on Pak because in Pak the client environment database does not account for variable network conditions after the initial selection of network data channel transmission velocity. Silen provides the disclosure and motivation for accounting for variable network conditions when downloading content over the network.

The Applicant presents the argument ... the [prior art does not disclose] synchronous playing of the content to be downloaded and the pre-stored content. The Examiner... disagrees ... Salmonsens, Figure 11, Column 26, lines 1-10 discloses a connection manager 1018 supports the content transfer subsystem 1012 and the format decoder subsystem 1014 and controls connection associated with a particular device including preparation to receive an incoming transfer, flow control and support of multiple simultaneous renders. Thus, Salmonsens-Sato-Pak-Silen disclose (re. Claim 1) synchronous playing of the

content to be downloaded and the pre-stored content. (Salmonsens-col. 26, lines 1-10, connection manger 1018 supports multiple simultaneous renderers, such that DVD content is played with downloaded content.”

Applicant thanks the Examiner for his further comments regarding the rejection of the claims.

However, Applicant continues to respectfully disagree with and explicitly traverse the rejection of the claims.

In supporting the maintenance of the of the rejection of the claims the Examiner assets first, the claims recite a negative limitation in that the ‘quality options being independent of rendering capabilities of said processing system’ does not further limit the claims and it would be obvious to modify Pak to include only the feature of the network capability and second, that Salmonsens discloses the simultaneous presentation of the content and downloaded content.

With regard to the recitation of a negative limitation not further limiting the claims. However, as is stated in MPEP section 2173.05(i) “[t]he current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation, So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claims complies with the requirements of 35 USC112, second paragraph.”

In this case, the claims explicitly recite that the quality is determined based on the bandwidth and not the render characteristics of the equipment upon which the content is to be presented. There is no ambiguity regarding what is claimed as the invention. The element of “quality options being independent of rendering capabilities of said processing system” does clearly teach what is not included in the quality menu and hence, provides significant difference to distinguish the invention claimed from the references cited.

With regard to the assertion that it would be obvious to amend Pak to use only the network elements within the quality menu, Applicant would note that in addressing obviousness determination under 35 USC 103, the ‘Supreme Court in KSR International Co. v. Teleflex Inc., (citation omitted) reaffirmed man of its precedents relating to obviousness including its holding in *Graham v. John Deere Col*, (citation omitted). In KSR, the Court also reaffirmed that “a patent composed of several elements is not provide obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” In this regard, the KSR court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the ... field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.”

Furthermore, the KSR count did not diminish the requirement for objective evidence of obviousness (“[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention. i.e., something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination. Uniroyal Inc. V. Rudlkin-Wiley Corp (citation omitted).

As characterized previously, Pak teaches that download considers the rendering capability of the equipment and, thus, the files illustrated by Pak include information regarding the capabilities of the rendering equipment.

For example, Pak teaches that “information related to the hardware specification of the client includes information related to a display, an audio player, language codes and the like. The information related to the display includes resolution, physical size, etc. (see para. 0034). In addition, Pak teaches that [i]n operation the client request the contents service server to download predetermined contents and transmits the environment information stored in the client environment information storage to the contents service server. **The environment information includes the information related to the hardware specification and the information related to the features of the network.** (see para. 0040). In addition Pak teaches “[t]he contents service server selects a type of contents from a plurality of types of contents ... based on the environment information suitable for the environment of the client.” (see para. 0040).

Thus, Pak explicitly teaches that the selection of a download is based at least on being suitable for the client environment (i.e., the hardware specifications of the rendering equipment). See also para. 0051, 0052 wherein based on the physical rendering characteristics one velocity of data transmission is selected over another (see page 4, lines 1-5).

The Office Action asserts that it would be obvious to only use the network criteria of Pak in determining quality that may be stored in the quality menu. See claim 2, “[t]he contents service server ... wherein the information related to the features ... comprises: information related to the hardware specification of the client ...”

However, **there is no objective teaching provided by Pak** for using only the network bandwidth as Pak specifically teaches using the hardware specification and is attempting to provide a selection feature of using **“information related to the hardware specification.”**

Thus, contrary to the assertions made in the Office Action, there is no objective reason that would provide motivation to remove the hardware

specification selection feature, as removing this selection feature removes a material element of Pak.

Hence, the use of only the network characteristics is contrary to the teachings of Pak.

In addition, the Office Action refers to Salmonsens for teaching the element of “for playing the combined content available for downloading and the pre-stored content synchronously.”

A review of the referred-to section of Salmonsens (col. 26, lines 1-13) reveals that Salmonsens teaches a system that allows for controlling characteristics of different dynamic instances that “enables functionality such as picture-in-picture.”

That is, Salmonsens teaches a system wherein two different images or instances may be played at the same time when a PIP function is used to present or display two images or instances.

However, the simultaneous presentation (according to a PIP function) is not comparable to a “synchronous” presentation, as is recited in the claims.

While Salmonsens discloses presentations may be simultaneous, there is no disclosure by Salmonsens that the presentations are “in synchronization” with other.

Hence, even if it could be said that the PIP function of Salmonsens provides information regarding the same content in both screens, there is no disclosure by Salmonsens that the playing of “the combined content available for downloading and the pre-stored content **synchronously.**”

That is, the claims recite an element that is more specific than the mere simultaneous presentation or display of two images or instances. While the two presentations of Salmonsens may be played at the same time there is no teaching that there is a synchronization between the two content being played. (i.e., “combined content available for downloading and the pre-stored content **synchronously.**”).

With regard to the specific rejection of the claims, applicant submits that for the remarks made herein, the rejection of the claims as being unpatentable under 35 USC 103 in view of the cited references has been addressed.

Applicant submits that for the remarks made, herein, the combination of the cited references fails to disclose all the elements recited in the claims and, hence, the subject matter claimed is patently distinguishable over the cited references.

Applicant submits that the reasons for the objections and rejections of the claims have been overcome and withdrawal of same is respectfully requested. The issuance of a Notice of Allowance is expressly requested.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

In order to advance the prosecution of the matter, applicant respectfully requests that any errors in form that do not alter the substantive nature of the

arguments presented herein be transmitted telephonically to the applicant's representative so that such errors may be quickly resolved or pursuant to MPEP 714.03 be entered into the record to avoid continued delay of the prosecution of this matter any further.

MPEP 714.03 affords the Examiner the discretion, pursuant to 37 CFR 1.135 (c), to enter into the record a bona fide attempt to advance the application that includes minor errors in form.

“[a]n Examiner may treat an amendment not fully responsive to a non-final Office Action by: (A) accepting the amendment as an adequate reply to the non-final Office action to avoid abandonment ... (B) notifying the applicant that the reply must be completed... (C) setting a new time period for applicant to complete the reply ...

The treatment to be given to the amendment depends upon:

(A) whether the amendment is bona fide; (B) whether there is sufficient time for applicant's reply ... (C) the nature of the deficiency.

Where an amendment substantially responds to the rejections, objections or requirements in a non-final Office action (and is bona fide attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat every rejection, objection or requirement), the examiner may simply act on the amendment and issue a new (non-final or final) Office action. The new Office action may simply reiterate the rejection, objection or requirement not addressed by the amendment (or otherwise indicate that such rejection, objection or requirement is no longer applicable).

This course of action would not be appropriate in instances in which an amendment contains a serious deficiency (e.g., the amendment is unsigned or does not appear to have been filed in reply to the non-final Office action)...”

However, if the Examiner believes that such minor errors in form cannot be entered into the record or that the disposition of any issues arising from this response may be best resolved by a telephone call, then the Examiner is invited to contact applicant's representative at the telephone number listed below to resolve such minor errors or issues.

Respectfully submitted,
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